

REMARKS

In the final Office Action,¹ the Examiner:

- (a) rejected claims 1-3 and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Berstis (U.S. Patent No. 6,564,005) ("Berstis");
- (b) rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Panjwani et al. (U.S. Publication No. 2002/0018569) ("Panjwani"); and
- (c) rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Arnold (U.S. Patent No. 5,956,408) ("Arnold").

Applicants amend independent claim 1 to improve form and clarity. Applicants amend dependent claims 2-9 only to improve form. Upon entry of this Amendment, claims 1-9 will remain pending in this application. Applicants respectfully traverse the rejections for at least the following reasons.

Rejection of Claims 1-3 and 6-9 under 35 U.S.C. § 102(e):

Applicants traverse the rejection of claims 1-3 and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Berstis. Berstis does not anticipate claims 1-3 and 6-9.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki*

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

Berstis does not teach or suggest each and every element recited in the claims. For example, Berstis does not teach or suggest “[a] device installed in a machine tool ... comprising: ... a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine-tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in independent claim 1 (emphasis added).

The Examiner alleged that “[r]e claim 1: Berstis teaches a machine tool program unauthorized-use preventing device comprising: ... a processing section [Fig 1A, elt 102] ..., when a device inherent password [master user password] ... is input (Fig. 3, elts 302 & 304; col 7, lines 14-16) ..., when a machine tool inherent password [user password] ... is input (Fig. 7, elts 402 & 404; col 8, lines 5-8) ...,” (final Office Action, p. 5-6, also see Advisory Action, p. 2, emphasis added). However, this is not correct.

Berstis discloses that “[t]he system prompts the master user for a password (step 302). The user enters his password (step 304), and the system authenticates him as the master user (step 306)” (col. 7, lines 14 - 16, emphasis added). Berstis also discloses that “the master user enters the new user's name and selects a password for the new user (step 316)” (col. 7, lines 43 - 45, emphasis added). Therefore, in such embodiments, Berstis does not teach or suggest “a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine

tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in independent claim 1 (emphasis added).

Berstis further discloses that “[n]ote that steps 300 through 306 could be replaced by various other types of security mechanisms, such as a smart card that authenticates the master user” (col. 7, lines 15 - 22), and that “a variety of security controls may be used for each user in the system [and] these security controls may include a smart card for each user, or some other type of security mechanism” (col. 7, lines 45 - 49). However, the data processing unit 102 with a smart card or other security controls, as taught by Berstis, cannot constitute “a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in independent claim 1 (emphasis added).

Therefore Berstis fails to teach or suggest each and every element recited in claim 1. The rejection of independent claim 1 and, hence, dependent claims 2, 3, and 6-9 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Rejection of Claim 1 under 35 U.S.C. § 103(a):

Applicants traverse the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Panjwani. No *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P.* § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P.* § 2143.01(III), *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(I), *internal citations omitted* (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P.* § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P.* § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the final Office Action has neither properly determined the scope and content of the prior art

nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the final Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

As discussed above, Berstis does not teach or suggest “[a] device installed in a machine tool ... comprising: ... a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine-tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in independent claim 1 (emphasis added).

Panjwani does not cure the deficiencies of Berstis. Panjwani discloses that “the mobile station and the service provider could exchange the public key over the air when the mobile user requests service. In this case the exchange could be secured using a password established between the user and the service provider, or using a public key of the manufacturer embedded in the mobile station at manufacture time” (para. [0046]). However, neither Berstis, nor Panjwani, nor any combination thereof, teaches “[a] device installed in a machine tool ... comprising: ... a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in independent claim 1 (emphasis added).

Furthermore, in the Response After Final filed March 9, 2009, Applicants noted that Berstis is directed to a multi-user video hard disk recorder, but Panjwani is directed

to a completely different field of endeavor, namely, a communication system including a mobile station. In view of the different fields of endeavor of the cited references, one of ordinary skill in the art would not be motivated to make the combination suggested in the Office Action.

The Advisory Action purported to respond to this reasoning. However, after correctly citing case law setting forth the requirement that references of a combination must be from the same fields of endeavor or must be addressing a common problem to support an obviousness rejection, the Advisory Action makes a statement completely irrelevant to the "field of endeavor" issue, stating that "[i]n this case, the data processing unit meets the 'machine tools' & 'machine tool programs' and its recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art" (Advisory Action, p. 2).

The fact remains that the two cited references are in different fields of endeavor and one skilled in the art would therefore have no motivation to combine the teachings of the cited references. This further establishes that no reason has been set forth as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. For this additional reason, no *prima facie* case of obviousness has been established, and the rejection of claim 1 must be withdrawn.

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the final Office Action, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the

claimed combinations. Thus, the final Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claim 1 is therefore improper and should be withdrawn.

Rejection of Claims 4 and 5 under 35 U.S.C. § 103(a):

As discussed above, Berstis does not teach or suggest “[a] device installed in a machine tool ... comprising: ... a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine tool inherent password is set by a manufacturer of the machine tool, and is different from the device-inherent password,” as recited in claim 1 and required by dependent claims 4 and 5 (emphasis added).

Arnold does not cure the deficiencies of Berstis. The Examiner alleged that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified Berstis to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium” (final Office Action, p. 9). However, whether this allegation is correct or not, neither Berstis, nor Arnold, nor any combination thereof, teaches “[a] device installed in a machine tool ... comprising: ... a processing section configured to receive a device-inherent password or a machine-tool inherent password ..., wherein the device-inherent password is set by a manufacturer of the device; and the machine tool inherent password is set by a manufacturer of the machine tool, and is different from the

device-inherent password," as recited in claim 1 and required by dependent claims 4 and 5 (emphasis added).

In view of the shortcomings discussed above, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the final Office Action does not clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claims 4 and 5 is improper and should be withdrawn.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 1-9 are in condition for allowance. Accordingly, Applicants request a favorable action.

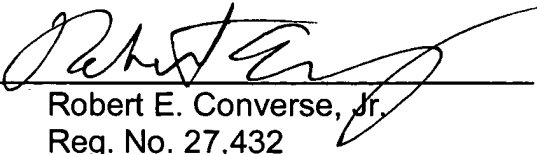
If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 28, 2009

By: 
Robert E. Converse, Jr.
Reg. No. 27,432